

04-30-01

A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. ORCH 0142 PUS

Anticipated Classification of this application

Class _____ Subclass _____

Prior application:

Examiner: _____

Art Unit: _____

11000 U.S. PTO
09/844980

04/27/01

Assistant Commissioner
for Patents
Box Patent Application
Washington, D.C. 20231

FILING UNDER 37 CFR 1.53(b)

- WARNING:** A c-i-p (continuation-in-part) cannot be filed under 37 CFR 1.53.
- WARNING:** Filing under 37 CFR 1.53 is permitted only if filed by the same or less than all the inventors named in the prior application.
- WARNING:** The filing of an application as the United States stage of an International Application requires an oath or declaration. 37 CFR 1.61(a)(4).
- WARNING:** The claims of this new application may be finally rejected in the first Office action where all claims of the new application are drawn to the same invention claimed in the earlier application and would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. MPEP '706.07(b).

This request for filing a

 X Continuation Divisional

application under 37 CFR 1.53, of pending prior application serial no. 09/321,170 filed on 05/27/99 of Robert D. Juncosa, et al.
(inventor(s))
for Genetic Assay System
(title of invention)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this 37 CFR 1.53 request and the documents referred to as attached therein are being deposited with the United States Postal Service on this date April 27, 2001 in an envelope as "Express Mail Post Office to Addressee" service under 37 CFR 1.10, Mailing Label Number EL 619994946 US addressed to the: Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Kevin G. Mierzwa
(Type or print name of person mailing paper)
[Signature]
(Signature of person mailing paper)

NOTE: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. (37 CFR 1.10(b)).

JC984 U.S. PRO
04/27/01

09844980-042701

NOTE: 37 CFR 1.53 permits the omission of a declaration only if the prior application was complete as set forth in 37 CFR 1.51(a), namely, the prior application comprised at least (1) a specification, including a claim or claims; (2) a declaration; (3) drawings when necessary; and (4) the prescribed filing fee. Accordingly, as presently worded, 37 CFR 1.53 does not permit this procedure to be used where the prior application is pending but only the processing and retention fee required by 37 CFR 1.21(1) is paid or where the declaration was not filed.

1. Copy of Prior Application as Filed Which is Attached

3. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary).

(check the next item, if applicable)

_____ There is provided herewith a Petition To Suspend Prosecution For The Time Necessary to File An Amendment (New Application Filed Concurrently).

4. Fee Calculation (37 CFR 1.16)

	No. Filed	No. Extra	Small Entity Fee	Large Entity Fee
Basic Fee			\$355	\$710.00
Total Claims	15 -20	0	x9 =	x18 =
Indep. Claims	4 -3	1	x40 =	x80 = \$ 80.00
Multiple Dependent Claims			+135 =	+270 =
			TOTAL	TOTAL \$790.00

_____ Fee for extra claims is not being paid at this time. (37 CFR 1.1b(d))

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency, 37 CFR 1.1b(d)).

Filing Fee Calculation \$790.00

5. Small Entity Status

_____ A verified statement that this filing is by a small entity:

_____ is attached

_____ has been filed in the parent application and such status is still proper and desired
(37 CFR 1.28(a))

Filing Fee Calculation (50% of above) \$ _____

NOTE: Any excess of the full fee paid will be refunded if a verified statement is filed within 2 months of the date of timely payment of a full fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

NOTE: 37 CFR 1.28(a), last sentence states: "Applications filed under '1.53 of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired."

6. Drawings

WARNING: Do not check the following box if prior case is not to be abandoned.

_____ Transfer the drawings from the prior application to this application and, subject to item 17 below, abandon said prior application as of the filing date accorded this application. A duplicate copy of this request is enclosed for filing in the prior application file. (May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record authorized by 37 CFR 1.138 and before payment of issue fee).

(37 CFR 1.53Bpage 3 of 8)

NOTE: "A registered attorney or agent acting under the provisions of '1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138.

_____ Transfer the following sheet(s) of drawing from the prior application to this application

TOLECHO 080119500

NOTE: Transferred sheets must be cancelled in prior application. 37 CFR 1.88.

_____ A copy of the amendment cancelling these sheets of drawing in the prior application is attached.

☒ New drawings are enclosed:

☒ formal

_____ informal

WARNING:

DO NOT submit original drawings. A high quality copy of drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards of 1.84. If corrections to the drawings are necessary, they should be made to the original drawings and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. Comments on proposed new 37 CFR 1.84. Notice of March 9, 1988 (1090 O.G. 57-62).

NOTE: "Identifying indicia such as the serial number, group art unit, title of the inventor, attorney's docket number, inventor's name, number of sheets, etc. not to exceed 2-3/4 inches (7.0 cm.) in width may be placed in a centered location between the side edges within three-fourths inch (19.1 mm.) of the top edge. Either this marking technique on the front of the drawing or the placement, although not preferred, of this information and the title of the invention on the back of the drawings is acceptable." Proposed 37 CFR 1.84(l). Notice of March 9, 1988 (1090 O.G. 57-62).

7. Priority - 35 U.S.C. 119

_____ Priority of application serial no. 0 / _____ filed on _____
_____ in _____ is claimed under 35 U.S.C. 119.
(country)

_____ The certified copy has been filed in prior U.S. application serial no. 0 /
on _____.

_____ The certified copy will follow.

8. Relate Back - 35 U.S.C. 120

☒ The enclosed Preliminary Amendment awards the specification to relate back to the parent case.

NOTE: The proper reference to a prior filed PCT application which entered the U.S. national phase is to

10/27/80 08:27:01

[illegible]

(complete appropriate items (a) and (b))

- (complete applicable item below)

less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

_____ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

X The prior application is assigned of record to Orchid BioSciences, Inc.
an assignment of the invention to _____
_____ is attached.

* 790.00

12. Method of Payment of Fees

☒ enclosed is a check in the amount of \$ 790.00

 charge Account No. in the amount of \$. A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that is clear for which purpose the fees are paid. 37 CFR 1.22(b).

13. Authorization To Charge Additional Fees

WARNING: If no fees are being paid on filing do not complete this item.

WARNING: Accurately count claims, especially multiple dependant claims, to avoid unexpected high charges if extra claim charges are authorized.

☒ The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the entire pendency of the application to Account No. 50-0476.

☒ 37 CFR 1.16(a), (f) or (g) (filing fees)

☒ 37 CFR 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependant claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)) it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

 37 CFR 1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under 1.13b(a) this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.13b(a) is to no avail unless a request or petition for extension is filed." [emphasis added]. Notice of November 5, 1985 (1060 E.G. 27).

 37 CFR 1.18 (issue fee at or before mailing Notice of Allowance, pursuant to 37 CFR 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the Notice of Allowance. 37 CFR 1.311(b)).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application. . . prior to paying or at the time of paying. . . issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

14. Power of Attorney

☒ The power of attorney in the prior application is to

Kevin G. Mierzwa
Attorney

38,049
Reg. No.

a.

☒ The power appears in the original papers in the prior application.

b.

 Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c. A new power has been executed and is attached.

d. X Address all future communications to:

Kevin G. Mierzwa, Esq.
Artz & Artz, P.C.
28333 Telegraph Road, Suite 250
Southfield, MI 48034

(Item d may only be completed by applicant, or attorney or agent of record)

15. Maintenance of Copendency of Prior Application

(This item must be completed and the papers filed in the prior application if the period set in the prior application has run)

 A petition, fee and response has been filed to extend the term in the pending prior application until _____

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the Continuation Application. Notice of November 5, 1985 (1060 O.G. 27).

 A copy of the petition for extension of time in the prior application is attached

16. Conditional Petition for Extension of Time in Prior Application

(complete this item and file conditional petition in the prior application if previous item not applicable)

 a conditional petition for extension of time is being filed in the pending parent application.

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the paper constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

 A copy of the conditional petition for extension of time in the prior application is attached.

17. Abandonment of Prior Application (if applicable)

WARNING: (Do not complete this item if the application being filed is a divisional of the prior application which is not being abandoned)

NOTE: "A registered attorney or agent acting under the provisions of 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138.

 Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

09344920.042701

I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4/27/01
Date

Kevin G. Mierzwa
Type or print name of person signing

[Signature]
Signature

P.O. Address of Signatory

28333 Telegraph Road
Suite 250
Southfield, Michigan 48034

Tel. No.: (248) 223-9500

on behalf of

Reg. No. 38,049
(if applicable)

____ Inventor

____ Assignee of complete interest

____ Person authorized to sign
assignee

X Attorney or agent of record

____ Filed under Rule 34(a)

(complete the following if applicable)

Orchid BioSciences, Inc.

Type name of assignee

Address of assignee
303 College Road East
Princeton, New Jersey 08540

Title of person authorized to sign on
behalf of assignee

Assignment recorded in PTO on _____

Reel _____ Frame _____